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EXAMINER	
KHOSHNOODI, NADIA	

ART UNIT	PAPER NUMBER
2133	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/774,844	GROSS, CURTIS T.	
	Examiner	Art Unit	
	Nadia Khoshnoodi	2133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 January 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 January 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/08-15-2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Part III DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Elements 306 and 308 in Figure 3.

Also, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "301" has been used to designate both a controlled-access network (element 310) and the Internet (element 301) on page 10, in line 23.

Finally, the drawings are objected to because the SMTP Mail Gateway (fig. 5, element 305) is referred to differently on page 10, line 10 of the specification, namely an SMTP server 305.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 2 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

As per claims 2 and 16:

If claims 1 and 15 intended all occurrences of said "transmitted message" to be said "transmitted email message" in lines 8 (for claim 1) and line 5 (for claim 15), then claims 2 and 6 do not further limit their corresponding parent claims. Applicant is required to amend claims 2 and 16 as well as their parent claims so that they are in proper dependent form.

Claim 23 is objected to because of the following informalities: It is unclear which requesting computing site is being referred to by "said requesting computing site" in lines 4-5. It could either be referring to "a requesting computing site" in line 2 or line 3. Furthermore, lines 3-5 should be reworded to more clearly define what aspect is data authenticating said requesting computing site. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph as lacking antecedent basis.

As per claim 1:

Claims 1 and 13 recite the limitation "said transmitted email message" in corresponding lines 8 and 2. Since a transmitted "email" message is not previously

introduced, there is insufficient antecedent basis for this limitation in the claim. However, since a "transmitted message" is previously introduced, it is presumed that the applicant intended to refer to the latter of the two choices.

As per claim 10:

Claim 10 recites the limitation "said controlled-access network" in line 2. Since claim 10 depends solely on claim 1 and neither of these claims previously introduced a controlled-access network, there is insufficient antecedent basis. A "controlled-access network" is previously introduced in line 2 of claim 7, so it is unclear as to whether or not the applicant intended claim 10 to depend on claim 7 or if he merely wishes to change "said" to "a" in line 2 of claim 10.

As per claim 15:

Claim 15 recites the limitation "said transmitted email message" in lines 5 and 8 where only a "transmitted message" has been introduced. Additionally, it recites the limitation "said second workstation" in lines 8, 10, and 11. A "second workstation" has not been previously introduced. However, "a workstation" is in line 6. Since there are no limitations of said workstation, it is presumed that the applicant intended to introduce a "second workstation" instead.

As per claim 18:

Claim 18 recites the limitation of an "email server," however there is no such antecedent basis for this email server as the specification never mentions an email server. Instead, the specification refers to a mail server.

As per claims 2-9, 11-12, 14, 16-17, and 19-22:

These remaining claims are rejected by virtue of their dependency.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1:

It is indefinite what applicant is claiming in lines 3-5. Perhaps if the word "and" was removed in line 4, it would be more clear. This wording is presumed in order to further examine these claims based on their merits.

As per claims 2-14:

These remaining claims are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 102

I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

II. Claims 1, 4, 6-9, 12, 15, 18, and 20-21 are rejected under 35 U.S.C. 102(b) as being fully anticipated by McManis United States Patent No. 5,680,461.

As per claim 1:

McManis teaches a method for sharing resources between first and second workstations separated by a segment of a public network, element 106 in figure 1, comprising the steps of transmitting a message (fig. 1, element 110) from said first workstation (fig. 1, element 102), to said second workstation (fig. 1, element 103)

separated from said first workstation by at least one security measure (fig. 1, element 105) disposed within a destination computing site (fig. 1, element 104), employing a protocol to enable said transmitted message to penetrate said at least one security measure (col. 4, lines 16-26 and fig. 1, element 105), and executing a command included in said transmitted message (col. 7, lines 51-65 and fig. 6, element 632).

As per claim 4:

McManis teaches a method where executing step comprises the step of performing an operation on data other than said transmitted message. See col. 7, lines 24-36.

As per claim 6:

McManis teaches a method where said at least one security measure is a firewall. See fig. 1, element 105.

As per claim 7:

McManis teaches a method disposing said destination computing site within a controlled-access network. Although the term "controlled-access network" is not explicitly stated, element 109 in fig. 1 represents the protected side of the network thus is identical to a "controlled-access network."

As per claim 8:

McManis teaches a method disposing said firewall (fig. 1, element 105) in between said public network (fig. 1, element 106) and said controlled-access network (fig. 1, element 109).

As per claim 9:

McManis teaches a method of attaching an executable file to said message referring to col. 4, lines 48-55 wherein said executing step comprises the step of executing said attached executable file as shown in fig. 6, element 632.

As per claim 12:

McManis teaches a method identifying said included command employing at least one script recognizable to said second workstation. Although the term "script" is not explicitly stated, element 706 of fig. 7 represents an object header identical to the script as disclosed in col. 4 line 63- col. 5 line 9. Also see fig. 6, elements 626-628 and col. 4, lines 10-15.

As per claim 15:

McManis teaches a method of a system for securely enabling resource sharing among a plurality of workstations over a public network in fig. 1 comprising means for transmitting a message (fig. 1, element 110) from a first workstation of said plurality of workstations (fig. 1, element 102) onto said public network (fig. 1, element 106), means for enabling said transmitted message to pass through a firewall (fig. 1, element 105 and col. 4, lines 16-26) separating said public network from a second workstation (fig. 1, element 103) disposed in communication with a controlled access network (fig. 1, element 109, which is the protected side of the network thus a controlled-access network) coupled to said public network (fig 1, element 106), means for receiving said transmitted message at said second workstation (fig. 6, element 626 and col. 4, lines 10-15), means for verifying an authorization of said first workstation to request execution of a selected function at said second workstation (col. 6, line 55- col. 7, line 12 and fig. 6, elements 628-632), and means for automatically performing said selected function at said second

workstation (col. 7, lines 24-36) if said authorization of said first workstation is verified (col. 6, line 66 – col. 7, line 4).

As per claim 18:

McManis teaches a method of an email server dedicated to said second workstation as depicted in fig. 1, elements 104 and 103, as well as a means for enabling communication between said dedicated email server and said second workstation in col. 3 lines 53-58. Although the server is not specifically called an email server, it is identical to the email server in regards to how it is defined in the applicant's specification. See fig. 6, elements 626-632.

As per claim 20:

McManis teaches the method of a system wherein said means for automatically performing comprises means for running an executable file attached to said message (fig. 6, element 632).

As per claim 21:

McManis teaches the method of a system where means for automatically performing comprises means for running an executable file identified in said message shown in fig. 6, element 632 and resident in said controlled-access network as depicted by element 109 in fig. 1. See col. 5, lines 3-9.

Claim Rejections - 35 USC § 103

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

IV. Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McManis United States Patent No. 5,680,461 as applied to claim 1 above.

As per claim 5:

McManis substantially teaches a method of a system wherein said means for verifying an identity of said first workstation in fig. 6, element 608 and means for verifying an identity at a firewall connected to a server dedicated to a second workstation (fig. 3, element 324 and col. 6, lines 24-46). McManis fails to explicitly disclose means for verifying an identity of said first workstation at said second workstation. However, McManis does display the second workstation indirectly connected to the firewall, which is where the identity of the first workstation is verified. Therefore, it would have been obvious because a person having ordinary skill in the art at the time the invention was made to modify the method disclosed in McManis to allow the second workstation to directly verify the identify of the first workstation. The modification of the firewall verifying the identity of the first workstation at the second workstation would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by McManis in fig. 2, element 224 and col. 4, lines 10-12.

As per claim 19:

McManis substantially teaches a method of a system wherein said means for verifying said authorization comprises means for generating a digital signature (see claim 2) at said first workstation (fig. 6, element 608) and means for decrypting said digital

signature at a firewall connected to a server dedicated to a second workstation (fig. 3, element 324 and col. 6, lines 24-46). McManis fails to explicitly disclose means for decrypting said digital signature at said second workstation. However, McManis does display the second workstation indirectly connected to the firewall, which is where the decryption of the digital signature occurs when the message is received from the first workstation. Therefore, it would have been obvious because a person having ordinary skill in the art at the time the invention was made to modify the method disclosed in McManis to allow the second workstation to directly decrypt the digital signature. The modification of allowing the second workstation to carry out the digital signature decryption, as opposed to the firewall, would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by McManis in fig. 2, element 224 and col. 4, lines 10-12.

V. Claims 2-3, 13-14, 16-17, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McManis United States Patent No. 5,680,461 as applied to claims 1 (for 2-3) and 15 (for 16-17 and 22) above, and further in view of Hong et al United States Patent No. 5,710,883.

As per claim 2:

McManis substantially teaches an email as the type in col. 7, lines 16-23, and a protocol in col. 4, lines 20-26, but fails to explicitly disclose the protocol as a Simple Mail Transfer Protocol. However, Hong et al. substantially teach the use of an email in fig. 3 in the second step of the box entitled "Transport Notes From Client to WWW Server." Hong et al. also substantially teaches a Simple Mail Transfer Protocol to be used as the specific protocol in col. 5, lines 15-24. Therefore, it would have been obvious

to a person in the art at the time the invention was made to modify the method disclosed in McManis to use an email message in place of the packet and a Simple Mail Transfer Protocol as the protocol. The modification of the packet to the email message would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by Hong et al. in col. 6, lines 5-12. As for implementing the protocol as a Simple Mail Transfer Protocol, the modification would have been made obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by Hong et al. in col. 6, lines 12-15.

As per claim 3:

McManis substantially teaches an executing step in fig. 6, element 632 where the second workstation automatically performs at least one operation selected from a group of extensive operations in col. 5, lines 3-18. McManis fails to explicitly disclose that step enabling an SMTP server dedicated to said second workstation to automatically perform at least one operation selected from a group of extensive operations. However, Hong et al. substantially teach an SMTP Server dedicated to the WWW Server, which is like the second workstation shown in fig. 3, to automatically perform at least one operation selected from a group of extensive operations, shown in fig. 3 as well. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in McManis to use an SMTP Server from fig. 3 in place of the server 104 in fig. 1 of McManis. The modification of the server to the SMTP Server would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by Hong et al. in col. 6, lines

12-15 to use an SMTP Protocol, thus using an SMTP Server to support the emails received.

As per claim 13:

McManis substantially teaches a method for a system with means of automatically performing operations attached to said transmitted message as seen in fig. 6, element 632. Not explicitly disclosed by McManis is a means for performing an operation on a document attached to said transmitted message. However, Hong et al. substantially teach a method for performing an operation on a document attached to said message. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the packet to perform a function on an attached document. This modification would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by Hong et al. in col. 5, lines 35-49.

As per claim 14:

McManis substantially teaches a method for a system with means of automatically performing operations attached to said transmitted message as seen in fig. 6, element 632. Not explicitly disclosed by McManis is a means for performing an operation on a document resident within said destination computing site. However, Hong et al. substantially teach a method for performing an operation on a document resident within said destination computing site. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the packet to perform a function on a document resident within said destination computing site. This modification would have been obvious because a person in the art at the time the

invention was made, would have been motivated to do so since it is suggested by Hong et al. in claim 9 with focus on the term "editing".

As per claim 16:

McManis substantially teaches an email as the type in col. 7, lines 16-23. Not explicitly disclosed by McManis is an actual email message. However, Hong et al. substantially teach the use of an email in fig. 3 in the second step of the box entitled "Transport Notes From Client to WWW Server." Therefore, it would have been obvious to a person in the art at the time the invention was made, to modify the method disclosed in McManis to specifically use an email message in place of the packet. The modification of the packet to the email message would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by Hong et al. in col. 6, lines 5-12.

As per claim 17:

McManis substantially teaches a protocol to enable communication of said message through a firewall in col. 4, lines 20-26. Not explicitly disclosed by McManis is an SMTP port. However, Hong et al. substantially teach the use of an SMTP port[1] in col. 5, lines 15-24. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in McManis to use a Simple Mail Transfer Protocol as the protocol, i.e. an SMTP port. The modification of the protocol as a Simple Mail Transfer Protocol would have been obvious because a person in the art at

[1] According to searchnetworking.techtarget.com:

> a port (noun) is a "logical connection place" and specifically, using the Internet's protocol, TCP/IP the way a client program specifies a particular server program on a computer in a network. In this case, SMTP protocol is used thus the use of an SMTP port is evident.

the time the invention was made, would have been motivated to do so since it is suggested by Hong et al. in col. 6, lines 12-15.

As per claim 22:

McManis substantially teaches a method for a system with means of automatically performing operations attached to said message as seen in fig. 6, element 632. Not explicitly disclosed by McManis is a means for performing an operation on a document attached to said message. However, Hong et al. substantially teach a method for performing an operation on a document attached to said message. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the packet to perform a function on an attached document. This modification would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by Hong et al. in col. 5, lines 35-49.

As per claim 23:

McManis substantially teaches a method of a system for causing a function to be performed at a destination computing site remote from a requesting computing site in col. 2, lines 1-22. McManis also substantially teaches a packet object generator, element 212 in fig. 2, which is analogous to the applicant's email composer disposed in communication with a requesting computing site for composing a message including a task description and data authenticating said requesting computing site. See col. 4, lines 43-46. Not explicitly disclosed by McManis is an email message. However, McManis substantially teaches the use of an email as a subclass of the type of packet. Furthermore, Hong et al. substantially teach the use of an email in fig. 3 in the second step of the box entitled "Transport Notes From Client to WWW Server." Therefore, it

would have been obvious to a person in the art at the time the invention was made, to modify the method disclosed in McManis to specifically use an email message in place of the packet. The modification of the packet to the email message would have been obvious because a person in the art at the time the invention was made would have been motivated to do so since it is suggested by Hong et al. in col. 6, lines 5-12. Additionally, McManis substantially teaches a method for a network link for enabling transmission of said composed email message in col. 4, lines 27-34. Not explicitly disclosed by McManis, once again, is the email message nevertheless the factors for obviousness as well as motivation are as stated previously. McManis fails to explicitly disclose a mail gateway. However, Hong et al. substantially teach a mail gateway disposed in communication with said destination computing site for receiving said transmitted composed email. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify fig. 1 of McManis to incorporate a mail gateway from Hong et al. The modification of incorporating the mail gateway would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by Hong et al. in col. 5, lines 31-34. McManis also substantially teaches a server dedicated to a destination computing device disposed within said destination computing site, found in protected side of the network (fig. 1, element 109), for identifying said task description in fig. 6 element 626-628. Not explicitly disclosed by McManis is a mail server. However, McManis substantially teaches a server that ultimately carries out functions identical to that of a mail server. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the server, element 103 of fig. 1, to a mail server because it has the same

functionality. The modification of the server to a mail server would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since the idea of compatibility and transmitting messages is suggested by McManis in col. 2, lines 6-10. Finally, McManis substantially teaches a means for verifying said authenticating data as depicted in fig. 6, element 620 and means for executing said described task where said authenticating data is verified in fig. 6, elements 622-632.

As per claim 24:

McManis substantially teaches a method wherein said authenticating data includes a digital signature in claim 2.

As per claim 25:

McManis substantially teaches a method wherein said destination computing site is coupled to a local area network as depicted by the protected side (109) of fig. 1.

VI. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McManis United States Patent No. 5,680,461 as applied to claim 1 above, and further in view of Tanno United States Patent No. 5,960,177.

As per claim 10:

McManis substantially teaches a method wherein said executing step performs a routine in said controlled-access network (protected side 109 of fig. 1) identified in said message in col. 2, lines 1-22. Not explicitly disclosed by McManis is a method wherein said executing step comprises the step of executing a routine resident in said controlled-access network identified in said message. However, Tanno substantially teaches the execution of a routine resident in said controlled-access network identified in said

message. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in McManis to incorporate a means to execute a routine resident in the controlled-access network as identified in the message. The modification of the message containing a routine to be executed that is resident in the controlled-access network would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by Tanno in col. 10, lines 1-21.

As per claim 11:

McManis substantially teaches a method wherein said executing step executes a command at the second workstation in fig. 6, element 632 and col. 4, lines 10-15. Not explicitly disclosed by McManis is a method wherein said executing step running a diagnostic program at said second workstation. However, Tanno substantially teaches a method wherein said executing step running a diagnostic program at said second workstation. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in McManis to incorporate a step of running a diagnostic program at said second workstation. This modification would have been obvious because a person in the art at the time the invention was made, would have been motivated to do so since it is suggested by Tanno in col. 10, lines 22-25.

Nadia Khoshnoodi
Patent Examiner
8-13-04

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